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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,615	12/22/2003	Mark S. Garrison	680.0039USQ	7572

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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07/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/743,615	Applicant(s) GARRISON, MARK S.	
	Examiner Gina C. Yu	Art Unit 1617	/

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,7,9-11,18,23-31,33-35,37,38,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 7, 9-11, 18, 23-31, 33-35, 37, 38, 40, 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 20, 2007 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 7, 9-11, 18, 23-31, 33-35, 37, 38, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bara et al. (US 6224851 B1) in view of Occupational Safety & Health Administration data (Chemical Sampling Information: Ethyl Perfluorobutyl Ether), Bretescu (US.6528070 B1), and Morrisou (US 2859085).

Claim 38 is directed to an oil and water emulsion comprising a volatile compound having a vapor pressure about 20-500 mbar at 25 °C and a boiling point about 45-110 °C, wherein the volatile compound does not totally dissolve in water or oil, and wherein the composition has a viscosity from about 5,000 cps to about 1,500,000 cps. Claim also recites that the composition has "textured surface appearance" which is "disturbed

after each use of the composition provided the disturbed composition is maintained for a pre-determined period of time in the sealed container”.

Bara teaches cosmetic water-in-oil emulsion foundation comprising 20 % by weight of perfluoromethylcyclopentane. See col. 8, Example 2; instant claims 1, 13-15, 19, 21, 26, 32, 38, 39. Oil-in-water emulsion is also taught in col. 6, lines 11-25; instant claim 2. The reference teaches, “the perfluoromethylcyclopentane can advantageously be replaced with an equivalent amount of ethoxynonafluorobutane”, which is ethoxy perfluorobutane, another name for ethyl perfluorobutyl ether, commercially available as HFE 7200 by Novec. See col. 3, lines 21-26; instant claims 17, 18, 32, 33, 39. The weight of the volatile components in the composition is disclosed in col. 8, lines 48-51. See instant claims 26-31 and 34-35.

The reference teaches that the fluorinated solvents disclosed therein have vapor pressure that is greater than 20 mbar at 25 °C and boiling points between 20-75 °C, thus the reference suggests that perfluoromethylcyclopentane and ethoxy- and methoxynonafluorobutane are within this limitation. See col. 2, lines 8 – 14; col. 3, lines 14 – 18; instant claim 18. The reference is silent as to the specific vapor pressure of the volatile perfluoro solvents.

OSHA data teaches that ethyl perfluorobutyl ether has vapor pressure of 109 mmHg (145.32 mbar) at 25 °C. See instant claims 22, 23.

Bara does not teach the specific viscosity of the composition. Since the emulsions are “preferably in the form of creams”, a skilled artisan would have been

motivated to formulate the invention in the viscosity range of conventional cream composition well known in the art.

Bratescu teaches that the viscosity of cosmetic emulsion composition can vary from thin as 100 cps, to cream like consistency of 80,000 cps. See col. 13, lines 33-35. See instant claims 2, 3-7, 32, 38, 40, 41. Thus formulating the Bara composition in the viscosity range as taught by Bratescu would have been obvious to the skilled artisan.

Bara, Occupational Safety & Health Administration Data, and Bretescu are discussed above. The references fail to teach a system comprising a container and a sealable and removable cap.

Morrisou teaches that containers for facial creams are conventionally in the form of jar and removable lid. See Figure.

While Bara does not indicate "the textured appearance" of the composition, examiner views that the prior art composition which contains the same volatile component in the same emulsion form as applicant's invention necessarily possesses the same texture characteristic as the claimed by applicant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the Bara composition contained in a jar and removable lid would possess the claimed texture and pressure-buildup property as claimed by applicants. Bara teaches making oil-in-water emulsion cream with volatile perfluorobutyl ethers, as required by applicants. The secondary references teach that the limitations on the vapor pressure of perfluorobutyl ether and the viscosity of the cream composition are obviously present in the Bara composition. The claimed method

of "imparting a self-renewing and self-leveling textured surface appearance to a composition after each use" by "maintaining the composition in a capped state for a pre-determined period of time after each use to allow the composition to self-renew and self-level the textured surface appearance of the composition" is viewed obvious over the normal and ordinary use of the composition of the combined references. It is obvious that the cosmetic composition is stored as capped state after each use; and it is viewed that such self-renewing and self-leveling as claimed by applicant would obviously occur in the composition made as motivated by the combined references.

Oath/Declaration

Declarations filed on June 20, 2007 have been fully considered but they do not overcome the present obviousness rejection.

Applicant/declarant states that First Declaration illustrates the surface appearance of a composition made as according to the present invention. The composition made therein contains 0.39% by weight of methoxynonafluorobutane in combination of other cosmetic materials. Second Declaration exemplifies a cosmetic containing different materials, void of any perfluoroether compound. Third Declaration states that the composition according to Example 2 of Bara which contains 20 % by weight of ethoxynonafluorobutane behaves as a soft cream and does not produce any renewed surface features after a disturbance of the texture.

Examiner takes the position that the comparison test does not adequately present whether the present invention has an unexpected, surprising and nonobvious result in view of the prior art. The tests have not been conducted in same conditions, as

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the constituents of the compositions of First and Third Declarations other than the perfluoro ethers are different, and the amount by which the perfluoro ether used is also inconsistent in the comparison. Furthermore, the composition in Third Declaration, which contains ethoxynonafluorobutane and having the viscosity which is within the claimed range, actually meets all the limitation of the claimed composition. Examiner views that the test essentially demonstrates that the claimed invention is not enabled within the full scope of the limitation of the claims.

Response to Arguments

Applicant's arguments filed June 20, 2007 have been fully considered but they are not persuasive for the reasons stated in Oath/Declaration above.

Conclusion

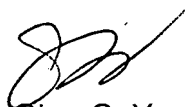
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu
Patent Examiner